



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

APPLICANT: Kim Simelius
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TITLE: METHOD AND APPARATUS FOR DATA TRANSMISSION

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APPELLANT'S BRIEF ON APPEAL

This Amended Appeal Brief is being submitted in response to the Notification of Panel Decision from Pre-Appeal Brief Review mailed April 02, 2008, regarding an appeal from the Final Office Action mailed November 27, 2007, and from that Final Office Action mailed November 27, 2007, finally rejecting claims 1-22.

As this Appeal Brief is being filed within one month of the mail date of the Notification of Panel Decision from Pre-Appeal Brief Review, Applicant believes that no petition for an extension of time is due. However, should the Applicant be mistaken, please consider this paper as a petition for a suitable extension of time.

If there are any deficiencies in payment, please charge deposit account no.: 50-1924 for any deficiency.

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TABLE OF CONTENTS

Real Party in Interest	3
Related Appeals and Interferences	4
Status of Claims	5
Status of Amendments After Final	6
Summary of Claimed Subject Matter	7
Grounds of Rejection to be Reviewed on Appeal	10
Arguments	11
Conclusion	26
Claims Appendix	27
Evidence Appendix	33
Related Proceedings Appendix	40

(1) REAL PARTY IN INTEREST

The real party in interest is Nokia Corporation of Espoo, Finland.

(2) RELATED APPEALS AND INTERFERENCES

The undersigned attorney is not aware of any related appeals or interferences.

(3) STATUS OF CLAIMS

The status of the claims is as follows:

Claims allowed: none

Claims objected to: none

Claims rejected: Claims 1-22.

Claims canceled: none

(4) STATUS OF AMENDMENTS AFTER FINAL

There has been no amendment proffered after the Final Office Action.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

There are three independent claims – 1, 15, and 22 – which are concisely explained below in accordance with MPEP Section 1205. Also, as certain dependent claims of claim 15 include “means” language, those claims are concisely explained below in accordance with MPEP Section 1205.

Claim 1 recites a method comprising: forming a data item for the first time in a first electronic device (Fig. 1a, 101; page 5, lines 28-29, of the application as filed), in response to said forming, providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item (Fig. 1a, 102); in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item with said existing grouping identifier (page 6, lines 20-30, of the application as filed), said existing grouping identifier being associable with at least one other data item (Fig. 1a, 104; page 6, lines 22-23, of the application as filed), in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item with the new grouping identifier (Fig. 1a, 106; page 6, lines 30-33, of the application as filed), selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier, and synchronizing said data item between said first electronic device and a second electronic device on the basis of said selected grouping identifier (Fig. 1c; page 10, line 23, through page 11, line 21, of the application as filed), said devices being capable of communication with each other (Fig. 1a, 105; page 9, lines 5-7, of the application as filed).

Claim 15 recites an electronic device (Fig. 3, 300) comprising: a memory (Fig. 3, 302) for storing a data item for a first time, associating means (Fig. 3, 303) for providing to a user of an electronic device a possibility to select an existing grouping identifier for the stored data item (Fig. 1a, 101, 103; page 5, lines 28-30, of the application as filed), for associating the stored data item with said existing grouping identifier in response to a situation in which the user selects said existing grouping identifier for the formed data item (page 6, lines 15-30, of the application as filed), and for obtaining a new grouping

identifier and associating the stored data item with the new grouping identifier in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item (Fig. 1a, 106; page 6, lines 30-31, of the application as filed), said existing grouping identifier being associable with at least one other data item stored into the memory of the electronic device (Fig. 3, 300), selecting means (Fig. 3, 307 and/or 309) for selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier for synchronization, and synchronizing means for synchronizing said data items between the electronic device and at least one another electronic device on the basis of the selected grouping identifier (page 9, lines 4-31, of the application as filed), said electronic devices being capable of communication connection with each other (e.g., page 9, line 9, of the application as filed).

Claim 16 recites the electronic device further comprises a register of at least one grouping identifier being associable to at least one data item stored into the memory of the electronic device (e.g., Fig. 2, 211-215, 221-225; page 10, lines 12-18; of the application as filed).

Claim 17 recites device according to claim 15, wherein said associating means are further arranged to select said existing grouping identifier from the register on the basis of an input of the user of the electronic device (e.g., Fig. 2, 211-215, 221-225; page 10, lines 12-18; page 10, lines 23-31, of the application as filed).

Claim 18 recites a device according to claim 15, wherein said associating means are further arranged to select said existing grouping identifier from a register automatically on the basis of information in the stored data item (e.g., Fig. 2, 211-215, 221-225; page 10, lines 12-18; page 9, lines 19-20, of the application as filed).

Claim 19 recites a device according to claim 15, wherein said associating means are further arranged to create the new grouping identifier on the basis of input of a user of the electronic device (Fig. 1a, 106; page 6, lines 30-31, of the application as filed).

Claim 20 recites a device according to claim 17, wherein said associating means are further arranged to store the new grouping identifier to the register of the electronic device (e.g., Fig. 2, 211-215, 221-225; page 10, lines 12-18; page 10, line 1, through page 11, line 21, of the application as filed).

Claim 21 recites a device according to claim 15, wherein said selecting means are further arranged to select the selected grouping identifier for the synchronization on the basis of input of a user of the electronic device (Fig. 1c; page 9, lines 4-31, of the application as filed).

Claim 22 recites a computer readable medium (Fig. 3, 302) encoded with a computer program (Fig. 3, 303) comprising: computer program means for causing a first electronic device (Fig. 3, 300) to store a data item for a first time into a memory (Fig. 3, 302) of the first electronic device (page 5, lines 28-29, of the application as filed), computer program means (Fig. 3, 303) for causing the first electronic device to provide to a user of the first electronic device a possibility to select an existing grouping identifier for the stored data item (Fig. 1a, 103; page 6, lines 18-30, of the application as filed), computer program means (Fig. 3, 303) for causing the first electronic device to associate the stored data item with said existing grouping identifier in response to a situation in which the user selects said existing grouping identifier for the formed data item (Fig. 1a, 104; page 6, lines 18-30, of the application as filed), and to obtain a new grouping identifier and to associate the stored data item with the new grouping identifier in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, said existing group identifier being associable with at least one other data item stored into the memory (Fig. 3, 302) of the first electronic device (Fig. 3, 300; page 6, lines 30-31, of the application as filed), computer program means (Fig. 3, 303) for causing the first electronic device to select one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier for synchronization (Fig. 1c), and computer program means (Fig. 3, 303) for causing the first electronic device to synchronize said data items between said first electronic device and at least one another electronic device (Fig. 3, 300; Fig. 1c; page 9, lines 4-31, of the application as filed) on the basis of said at least one selected grouping identifier, said electronic devices (Fig. 2, 201, 210; page 10, lines 1-10, of the application as filed) being capable of communication connection with each other.

**(6) GROUND OF REJECTION TO BE REVIEWED ON
APPEAL**

- I. Whether the Patent Office properly rejected Claims 1-22 under 35 U.S.C. 102(b) as being anticipated by Celik, U.S. Published Patent Application No. 2004/0236792.

- II. Whether the Patent Office properly rejected Claims 1-8, 12-20, and 22 under 35 U.S.C. 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199?

- III. Whether the Patent Office properly rejected Claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199, in view of Hunkins, U.S. Patent No. 6,141,663?

(7) ARGUMENT

PROLOG

Please note that Celik, U.S. Published Patent Application No. 2004/0236792, had been cited by the Patent Office in rejecting claims 1-22 as a 35 U.S.C. 102(b) reference in the Final Office Action dated November 27, 2007. Celik was first applied as a 35 U.S.C. 102(b) reference in the June 29 2007 non-final office action. Appellant, as Applicant, discussed the inapplicability of Celik as a 35 U.S.C. 102(b) reference on pages 9-11 of the response filed September 13 2007. Certain points raised then were how Celik, Published Patent Application No. 2004/0236792, with a filing date of June 29 2004, could be a 35 U.S.C. 102(b) reference, or even any kind of prior art reference, against Appellant's invention as the filing date of Appellant's patent application is August 20, 2003. It was further argued that the Patent Office failed to treat all claim limitations using Celik, Published Patent Application No. 2004/0236792 (see page 11, lines 17-24, of the response filed on September 13, 2007). In reply to Appellant's September 13 2007 response, the Patent Office issued a Final Office Action dated November 27, 2007. On pages 19-20, of this Final Office Action, the Patent Office erroneously asserted that Celik, Published Patent Application No. 2004/0236792, is a valid 35 U.S.C. 102(b) reference as it is a continuation-in-part whose effective filing date makes it a 35 U.S.C. 102(b) reference over Appellant's application and that the grouping identifier is the unique user identifier and the data item is the personal information that is targeted to be synced as described in Figures 1, 2A, and 2B. Appellant felt compelled at this point to file a Request for a Pre-Appeal Brief Conference with a Notice of Appeal to correct the blatant errors in the persistence of the Patent Office in treating Published Patent Application No. 2004/0236792 as a 35 U.S.C. 102(b) reference and in insisting that the reference taught all the claimed subject matter of the claims. The Request for the Pre-Appeal Brief Conference Review contained two claims of clear error by the Patent Office in using Published Patent Application No. 2004/0236792: 1) a failure to treat all claim limitations and 2) misapplication of 35 U.S.C. 102(b) and failing to attribute significance to newly added subject matter in a continuation-in-part patent application.

Appellant does not believe that the other prior art rejection, based on Alam and Champagne, is a proper rejection. However, Appellant felt it necessary to single out discussion in the Pre-Appeal Brief Conference Review to Celik, Published Patent Application No. 2004/0236792, because the persistent use of this application to Celik was rather egregious and clearly disregarded proper application of 35 U.S.C. 102 and the Manual of Patent Examining Procedure.

The Notice of Panel Decision from Pre-Appeal Brief Review, mailed on April 2, 2008, states in item 2, in handwriting, "The 102 rejection over Celik will be withdrawn." Reference may be had to the February 27, 2008, Request for the Pre-Appeal Brief Review.

Upon receiving the Notice of Panel Decision from Pre-Appeal Brief Review, the Appellant called the examiner and asked if a new Office Action would be forthcoming. The examiner said no. The Appellant asked the examiner if there was a need to respond to the rejection by Celik in the Appeal Brief. The examiner said no. 37 C.F.R. 1.2 may be especially pertinent here. In re Milton (Patent Petition 2007), concerning U.S. patent application serial no. 09/938,465, refers to 37 C.F.R. §1.2, which states that all business with the U.S. Patent and Trademark Office (USPTO) should be transacted in writing and that no attention will be paid to any alleged oral promise in relation to which there is disagreement or doubt. In in re Milton, the director of petitions rejected a patent attorney's petition for revival on the basis of an oral promise by the examiner.

37 C.F.R. 1.2 reads as follows:

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

A further problem, especially in light of Appellant's telephonic conversations with the examiner and the handwritten sentence of "The 102 rejection over Celik will be withdrawn," is that this quoted sentence from the Notice of Panel Decision from Pre-Appeal Brief Review does not specify a time frame for when the 102 rejection will be

withdrawn. Since there is uncertainty when the 102 rejection will be withdrawn, and thus there is doubt, Appellant feels compelled to include discussion of the rejection by Celik, U.S. Published Patent Application No. 2004/0236792, within this Appeal Brief.

ISSUE I

At issue is whether the Patent Office properly rejected Claims 1-22 under 35 U.S.C. 102(b) as being anticipated by Celik, U.S. Published Patent Application No. 2004/0236792.

For a claim to be anticipated, all non-inherent limitations must be found (usually) in a single reference (from MPEP 2131).

FAILURE TO TREAT ALL CLAIM LIMITATIONS

The Patent Office did not identify with specificity where in the prior art reference the claimed subject matter of both an “existing grouping identifier” and a “new grouping identifier” is disclosed.

Regarding the “grouping identifier” and “data item,” the Patent Office asserted in lines 1-3 of page 20 of the Final Office Action dated November 27 2007 as follows: “The Examiner refers to Figures 1, 2A, and 2B. The grouping identifier is the unique user identifier and the data item is the personal information that is targeted to be synced as described in Figures 1, 2A, and 2B.”

Does the Patent Office mean that the “ID Number” is the grouping identifier? If so, then how does Celik account for “an existing grouping identifier” as well as “a new grouping identifier?” And, how would one of ordinary skill select between the existing grouping identifier and the new grouping identifier? On page 3, lines 4-6, of the Final Office Action dated November 27 2007, the Patent Office asserted “selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier, synchronizing said data items” as being taught by Celik, U.S. Published Patent Application No. 2004/0236792, presumably in Figure 2B (line 8, on page 3 of that Final Office Action).

Figure 2B of Celik shows ‘120’ for ‘Assign account and unique ID’ and ‘130’ for “Print business cards with IDs (barcode optional).” There does not appear to be any selection, as recited in the claims, between an “existing grouping identifier” and a “new grouping identifier.”

The Patent Office, on pages 2-3, of the Final Office Action dated November 27 2007, refers to paragraphs [0041]-[0043] of Celik, U.S. Published Patent Application No. 2004/0236792, (same as col. 5, line 65 – col. 7, line 34 of the Celik’s patent US6374259) with respect to the following features of the independent claims of the present application:

in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item with said existing grouping identifier, said existing grouping identifier being associable with at least one other data item, in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item with the new grouping identifier,

The Patent Office does not specify which feature or element recited in paragraphs [0041]-[0043] of Celik, U.S. Published Patent Application No. 2004/0236792, and that would correspond to the existing grouping identifier” and/or to “the new grouping identifier” recited in the above features.

Applicant could not find any other interpretation except that the Patent Office considers a “password” mentioned in the above passages of Celik, U.S. Published Patent Application No. 2004/0236792, as corresponding to the “existing grouping identifier” and/or to “the new grouping identifier” recited in the above features. In the paragraphs [0041]-[0043] of Celik, U.S. Published Patent Application No. 2004/0236792, the password is an element that can be established and changed by a user (changing = creating a new password that replaces an old one).

However, if the “existing grouping identifier” and/or “the new grouping identifier” recited in the above features are made to correspond to the password, the following features of the independent claims are not taught by Celik, U.S. Published Patent Application No. 2004/0236792, (added remarks are in brackets):

“selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier [when a new password is created it replaces the old one, therefore an “existing password” and a “new password” cannot not be available for selection], and synchronizing said data items between said first electronic device and a second electronic device

on the basis of said selected grouping identifier, said devices being capable of communication with each other
[Celik does not teach to synchronize electronic devices on the basis of a password].”

Therefore, Celik, U.S. Published Patent Application No. 2004/0236792, does not teach all the limitations of the independent claims of the present application. Hence, the teaching of Celik, U.S. Published Patent Application No. 2004/0236792, does not anticipate the independent claims.

As such, Celik, U.S. Published Patent Application No. 2004/0236792, cannot anticipate claims 1-22.

MISAPPLICATION OF 35 USC 102(b) AND FAILING TO ATTRIBUTE SIGNIFICANCE TO NEWLY ADDED SUBJECT MATTER IN A CONTINUATION-IN-PART PATENT APPLICATION

The Patent Office first treated Celik, U.S. Published Patent Application No. 2004/0236792 as a 35 U.S.C. 102(b) reference and second did not separate out subject matter commonly disclosed by Celik, U.S. Published Patent Application No. 2004/0236792, but not disclosed by earlier patent applications from which Celik claims priority.

Celik, U.S. Published Patent Application No. 2004/0236792, is not a 35 U.S.C. 102(b) reference. It cannot be because it was not published or patented more than one year before the effective filing date of Applicant’s patent application. **The effective filing date of a reference, not the application being examined, is irrelevant for the purposes of applying sub-section b) of 35 U.S.C. 102.**

MPEP § 706.02(a) states “If the publication or issue date of the reference is more than 1 year prior to the effective filing date of the application (MPEP § 706.02), the reference qualifies as prior art under 35 U.S.C. 102(b).” As Celik, U.S. Published Patent Application No. 2004/0236792, was not published until November 25 2004, it cannot be a 35 U.S.C. 102(b) reference against Applicant’s current patent application.

As far as to whether U.S. Patent No. 6,374,529, may apply, the matter is moot as the Patent Office has not applied this reference.

Because, as the Patent Office correctly noted on page 19 of the Final Office Action dated November 27 2007, where Figures 1-8 of Celik, U.S. Published Patent

Application No. 2004/0236792, and Figures 1-8 of Celik, U.S. Patent No. 6,374,259, form common subject matter, that commonly disclosed subject matter would be accorded the benefit of the filing date of the earlier of the two (i.e., Celik, U.S. Patent No. 6,374,259).

MPEP § 201.11 states as follows:

Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. The statute is so worded that the prior application may contain more than the later-filed application, or the later-filed application may contain more than the prior application, and in either case the later-filed application is entitled to the benefit of the filing date of the prior application as to the common subject matter disclosed in compliance with 35 U.S.C. 112, first paragraph.

As such, as pointed out on pages 9-10 of our response of September 17 2007, paragraphs 0065-0070 of Celik, U.S. Published Patent Application No. 2004/0236792, were newly added and so cannot qualify as prior art to reject the claims. Yet the Patent Office did just this for claims 8, 9, 10, 12, 20, and 21, in the Final Office Action dated November 27 2007.

The Notice of Panel Decision from Pre-Appeal Brief Review, mailed on April 2, 2008, states in item 2, in handwriting, "The 102 rejection over Celik, U.S. Published Patent Application No. 2004/0236792, will be withdrawn." No time frame for withdrawing the 102 rejection using Celik, U.S. Published Patent Application No. 2004/0236792, has been provided orally or in writing. The Pre-Appeal Brief Review Panel did consider the rejection based on Celik's published patent application to have met the USPTO's threshold as being "clear error."

The persistent misapplication of Celik, U.S. Published Patent Application No. 2004/0236792, has contributed to delaying the prosecution process. This delay in the prosecution process prejudices Applicant's efforts in obtaining a patent.

ISSUE II

At issue is whether the Patent Office properly rejected Claims 1-8, 12-20, and 22 under 35 U.S.C. 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199.

The independent claims of the present application recite the following features i) a formed data item is associated with a grouping identifier; ii) the grouping identifier is associable with at least one other data item for grouping the data items; iii) at least one grouping identifier is selected, and iv) data items between a first electronic device and a second electronic device are synchronized on the basis of the at least one selected group identifier.

CLAIMS 1- 22

The Patent Office asserts the solution recited in the independent claims of the present application are unpatentable in light of prior art publications Alam et al. (US 6324544) and Champagne (US 2005/0086199). The Patent Office asserts the same text passages of Alam and Champagne in rejecting the independent claims in the Final Office Action dated November 27 2007 as it did in the previous Office Action dated June 29 2007.

Claim 1 recites, in pertinent part, as follows:

in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item to said existing grouping identifier, said existing grouping identifier being associable with at least one other data item, in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item to the new grouping identifier

Claims 15 and 22 recite similar subject matter to the above portion of claim 1.

Furthermore, claim 1 recites “in response to said forming, providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item.”

The claimed subject matter of the independent claims makes possible that a user of an electronic device can form tailored grouping of data items. Neither Alam nor Champagne teaches the above-recited subject matter.

Alam (US 6324544) discloses a solution in which data can be synchronized between a first computing device and a second computing device in such a way that undesired duplicate data can be avoided, e.g., in a situation in which a file is renamed on

the first (or second) computing device. This is based on determining whether a file (or like) already exists in a computing device under a different name after adding said file into said computing device and deleting the file with the different name if it existed.

Champagne (US 2005/0086199) discloses a solution for transferring records between databases that may have different organizations of data in records of databases. The organization of data in records is expressed with a quantity expressing the number of data fields in a record and with information characterizing the data fields. A data field is characterized with "category" information that defines a type of information the field is meant to contain (e.g. a name of a person, an address, etc) and with "property" information that defines a format of data contained by the field (e.g. number of bits, integer, text, etc). In the solution disclosed by Champagne, a field map is established by correlating a plurality of data fields of a first database to a plurality of data fields of a second database using the above-mentioned information. Data synchronization between the first and the second database is performed using the field map.

The passages of Champagne cited by the Patent Office on pages 8-9 of the Office Action dated June 29 2007 are paragraphs 0036 and 0011.

Champagne discloses in paragraph 0036 as follows:

[0036] The category of a field defines the type of information the field is designed or meant to contain. Databases are generally designed to store data for a particular application, for example, airline reservations, medical records, etc. In the case of personal information manager (PIM) applications, several types of databases are typically used, where the type of a database corresponds to the type of data stored in the database: appointments, "to do" lists, address books, expense records, general notes records, and e-mails. For these types of databases, a field identification protocol preferably provides a comprehensive list of field categories such that the fields of most, if not all, of commercially available PIM databases can be categorized according to the categories in the field identification protocol. (The same can also be done for other types of databases.) For example, in the case of an address book type database, the categories may include: name, last name, first name, middle initial, address, street name, city, state, home telephone number, business telephone number, etc. Then, for example, the record structure of remote database 32 may include a field that is

of the category "name". The record structure of host database 12 may include equivalent fields of the categories "last name," "first name," and "middle initial," but not necessarily a field of the category "name". In other embodiments, the field identification protocol provides a list of field categories for a selected group of databases or for those databases designed to conform to the protocol.

Champagne discloses in paragraph 0011 as follows:

[0011] In a third aspect, in order to transmit data between two databases, information identifying the record structure of one of the two databases is transmitted to a computer program. This transmitted information identifies both the categories and the properties of a plurality of fields of the record structure of one of the two databases. Data stored in a plurality of fields of a plurality of the records of the first database is then transmitted from one of the two databases to the other one of the two databases. The transmitted data is then processed using the identifying information.

The categories of Champagne, at least from paragraphs 0011 and 0036, appear to be static in number. Champagne, at least in these passages, does not disclose obtaining a new category. The currently pending claims recite that a new grouping identifier may be obtained. That new grouping identifiers can be obtained/ created in conjunction with storing data items opens a door for a tailored grouping of data items that, according to Applicant's understanding, is not disclosed or made obvious by the prior art of record.

In particular, the Patent Office refers to paragraph [0011] of Champagne with respect to the following feature of the independent claims of the present application:

in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item with the new grouping identifier

The paragraph [0011] of Champagne recites:

[0011] In a third aspect, in order to transmit data between two databases, information identifying the record structure of one of the two databases is transmitted to a computer program. This transmitted information identifies both the categories and the properties of a plurality of fields of the record structure of one of the two databases. Data stored in a plurality of fields of a plurality

of the records of the first database is then transmitted from one of the two databases to the other one of the two databases. The transmitted data is then processed using the identifying information.

The above citation of Champagne does not teach to obtain a new grouping item and to associate a formed data item with the new grouping item as a response to a situation in which a user does not want to use an existing grouping identifier for the formed data item. The Patent Office states in page 8 of the Office Action: “*The preceding text clearly indicates that synchronizing data is transmitting data from the first electronic device, which is the first database, and second electronic device, which is the second database, based on the selected identifier, which is the identifying information.*” Hence, not even the Patent Office argues that the above citation of Champagne would teach to obtain a new grouping item and to associate a formed data item with the new grouping item as a response to a situation in which a user does not want to use an existing grouping identifier for the formed data item. Therefore, the disclosures of Alam and Champagne do not separately or as a combination lead a person skilled in the art to a solution recited in the independent claims.

On the basis of the above-mentioned facts the Office Action does not present a solid chain of arguments that would justify the claim rejections.

Therefore, the disclosures of Alam and Champagne do not separately or as a combination lead a person skilled in the art to a solution that enables a user of an electronic device to form tailored grouping of data items and the solution recited in the proposed amended is not taught or made obvious by Alam and Champagne.

Thus, claims 1-8, 12-20, and 22 are allowable over the combination of Alam and Champagne.

CLAIM 3

Claim 3 recites “a method according to claim 1, wherein the new grouping identifier is formed by the user of the first electronic device or the new grouping identifier is retrieved from a network server.”

Where does Champagne teach “a new grouping identifier” and “a new grouping identifier formed by the user of the first device” or “retrieved from a network server?”

These elements do not appear to be found in paragraph 0036 of Champagne, cited by the Patent Office.

As such, claim 3 and its dependent claims 5-7 are allowable over Alam in view of Champagne.

CLAIMS 4, 8, 16, AND 20

Claim 4 recites “a method according to claim 1, wherein the method further comprises maintaining a register of at least one grouping identifier being associable to at least one data item stored into a memory of the first electronic device.”

The Patent Office asserted that paragraph 0036 of Champagne teaches this subject matter. However, what is the “register” and what is the “at least one grouping identifier” in this passage?

Barring such disclosure and also barring disclosure of “at least one grouping identifier being associable to at least one data item stored into a memory of the first electronic device,” claim 4 and its dependent claim 8 are allowable over Alam in view of Champagne.

For similar reasons as to the allowability of claims 4 and 8, claims 16 and 20 are allowable.

CLAIMS 5 AND 17

Claim 5 recites “a method according to claim 3, wherein said existing grouping identifier is manually selected from a register by the user of the first electronic device.”

As with intervening claim 3, where does Champagne teach “a new grouping identifier” and “a new grouping identifier formed by the user of the first device” or “retrieved from a network server?” Furthermore, where does Champagne disclose or suggest an “existing grouping identifier is manually selected from a register by the user of the first electronic device?”

Barring such disclosure, claim 5 is allowable over Alam in view of Champagne.

For similar reasons as to the allowability of claim 5, claim 17 is allowable.

CLAIMS 6 AND 18

Claim 6 recites “a method according to claim 3, wherein said existing grouping identifier is automatically selected from the register by the first electronic device.”

As with intervening claim 3, where does Champagne teach “a new grouping identifier” and “a new grouping identifier formed by the user of the first device” or “retrieved from a network server?” Furthermore, where does Champagne disclose or suggest an “existing grouping identifier is automatically selected from a register by the user of the first electronic device?”

Barring such disclosure, claim 6 is allowable over Alam in view of Champagne.

For similar reasons as to the allowability of claim 6, claim 18 is allowable.

CLAIMS 7 AND 19

Claim 7 recites “a method according to claim 3, wherein the new grouping identifier is formed by a user of the first electronic device.”

The cited passage of Champagne, abstract, does not disclose that a user of the first electronic device forms the new grouping identifier. Someone or something else could do this.

As such, claim 7 is allowable over Alam in view of Champagne.

For similar reasons as to the allowability of claim 7, claim 19 is allowable.

CLAIMS 12 AND 14

Claim 12 recites “a method according to claim 1, wherein the selected grouping identifier comprises an icon to be visually presented to a user of the first device.”

The Patent Office asserted that Alam, in column 6, lines 54-66, teaches claim 12. However, Alam does not recite an icon in the cited passage or elsewhere in Alam and does not show an icon. Thus, claim 12 and its dependent claims 13 and 14 are allowable over Alam in view of Champagne.

CLAIM 13

Claim 13 recites “a method according to claim 12, wherein the selected grouping identifier further comprises text to be visually presented to the user of the first device.”

The Patent Office asserted that Alam teaches claim 12 in column 6, lines 54-66; however, Alam does not disclose the selected grouping identifier further comprises text to be visually presented to the user of the device.

Thus, claim 13 stands alone and is allowable over Alam in view of Champagne.

ISSUE III

At issue is whether the Patent Office properly rejected Claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199, in view of Hunkins, U.S. Patent No. 6,141,663.

Hunkins does not cure the above noted deficiencies of Alam and Champagne.

Hunkins shows, in Figure 3, that for external systems are updated and synchronized. These four external systems are PBX 11, Directory 12, Call Accounting 13, and Voice Mail 14.

The Patent Office asserted that column 2, lines 49-53, column 4, lines 12-16, and column 8, lines 6-18, of Hunkins to provide teachings that disclose the subject matter of claims 9-11 and 21.

Hunkins, column 2, lines 49-53, recites as follows:

Manual Update. Each of the databases containing redundant data can be viewed as islands of automation. Information that is common to all can be updated by manually entering the information into each of the separate databases. This is an extremely common method. The greatest disadvantage is that the amount of work necessary for one change is multiplied for each database containing the redundant data to be updated. Consequently, a large human error factor is introduced and it is difficult if not impossible to have all of the redundant data perfectly synchronized.

Hunkins, column 4, lines 12-16, recites as follows: "It is an object of the present invention to allow redundant data to be updated automatically, without human intervention, in order to provide and preserve data integrity and synchronization."

Hunkins, column 8, lines 6-18, recites as follows:

When the scheduled time is reached, the preferred embodiment begins processing each Change Object one by one. Each Change Object is asked for its database references. With this information, all available Format files, like those listed in 1c are scanned to see if the changed data is also appearing in an outside data file. If it is, the external data file is located with the link file as shown 1e and the Format file is used to surgically update the external data file. Since the complete format is now known, this is a manageable problem. When the project file is completed and all Change Objects have been executed, all external data files are synchronized to the common database.

As none of these cited passages of Hunkins discloses selecting the selected grouping identifier for synchronization manually, periodic synchronization, or selecting the selected grouping identifier for the synchronization on the basis of input of a user of the electronic device, claims 9-11 and 21 are allowable over Alam in view of Champagne and further in view of Hunkins.

CLAIM 9

Claim 9 recites “a method according to claim 1, wherein a user of the first electronic device selects the selected grouping identifier for the synchronization manually.”

There does not appear to be any disclosure or suggestion of a first device selecting the selected grouping identified for the synchronization manually. Hunkins, in column 2, lines 49-53, does not appear to disclose or suggest selecting the selected grouping identifier. Hunkins, in column 2, lines 53-58, teaches away from manual updating also since it is consider to update databases containing redundant data.

Thus, claim 9 is allowable over Alam in view of Champagne and further in view of Hunkins.

CLAIM 10

Claim 10 recites “a method according to claim 1, wherein the first electronic device selects the selected grouping identifier for the synchronization automatically.”

Hunkins discloses in column 4, lines 12-16, that it is an object of his invention to allow redundant data to be updated automatically. However, Hunkins does not teach in this cited passage that the first device selects the selected grouping identifier for the synchronization automatically.

Thus, claim 10 is allowable over Alam in view of Champagne and further in view of Hunkins

CLAIM 11

Claim 11 recites “a method according to claim 1, wherein the first electronic device performs the synchronization periodically.”

Hunkins, in column 8, lines 6-18, the passage relied upon by the Patent Office for a teaching for claim 11, does not disclose periodic synchronization but a scheduled

synchronization. A scheduled synchronization, every if done a plurality of times, is not necessarily periodic.

Thus, claim 11 is allowable over Alam in view of Champagne and further in view of Hunkins

CLAIM 21

Claim 21 recites “a device according to claim 15, wherein said selecting means are further arranged to select the selected grouping identifier for the synchronization on the basis of input of a user of the electronic device.”

Hunkins does not disclose a selecting means which is arranged to select the selected grouping identifier for the synchronization in column 2, lines 49-53.

Thus, claim 21 is allowable over Alam in view of Champagne and further in view of Hunkins

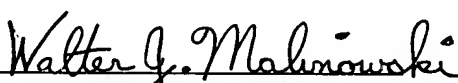
For the reasons provided above, it is respectfully submitted that the Patent Office has failed to establish a prima facie case of obviousness.

CONCLUSION

For the above reasons, it is respectfully requested that in each of the rejections discussed herein under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a), the Patent Office has failed to meet the burden in establishing a prima facie basis for the rejections of Claims 1-22. Accordingly, reversal of all outstanding rejections is earnestly solicited.

Respectfully submitted,

Dated: May 02, 2008


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(9) CLAIMS

1. A method comprising:

forming a data item for the first time in a first electronic device,

in response to said forming, providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item;

in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item with said existing grouping identifier, said existing grouping identifier being associable with at least one other data item,

in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item with the new grouping identifier,

selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier, and

synchronizing said data item between said first electronic device and a second electronic device on the basis of said selected grouping identifier, said devices being capable of communication with each other.

2. A method according to claim 1, wherein each grouping identifier comprises at least one of the following: text, still picture, moving picture, sound or vibration effect.

3. A method according to claim 1, wherein the new grouping identifier is formed by the user of the first electronic device or the new grouping identifier is retrieved from a network server.
4. A method according to claim 1, wherein the method further comprises maintaining a register of at least one grouping identifier being associable to at least one data item stored into a memory of the first electronic device.
5. A method according to claim 3, wherein said existing grouping identifier is manually selected from a register by the user of the first electronic device.
6. A method according to claim 3, wherein said existing grouping identifier is automatically selected from the register by the first electronic device.
7. A method according to claim 3, wherein the new grouping identifier is formed by a user of the first electronic device.
8. A method according to claim 4, wherein the new grouping identifier is stored to the register of the first electronic device.
9. A method according to claim 1, wherein a user of the first electronic device selects the selected grouping identifier for the synchronization manually.

10. A method according to claim 1, wherein the first electronic device selects the selected grouping identifier for the synchronization automatically.

11. A method according to claim 1, wherein the first electronic device performs the synchronization periodically.

12. A method according to claim 1, wherein the selected grouping identifier comprises an icon to be visually presented to a user of the first device.

13. A method according to claim 12, wherein the selected grouping identifier further comprises text to be visually presented to the user of the first device.

14. A method according to claim 12, wherein the selected grouping identifier further comprises information of those data items associated to said grouping identifier.

15. An electronic device comprising:

a memory for storing a data item for a first time,

associating means for providing to a user of an electronic device a possibility to select an existing grouping identifier for the stored data item, for associating the stored data item with said existing grouping identifier in response to a situation in which the user selects said existing grouping identifier for the stored data item, and for obtaining a new grouping identifier and associating the stored data item with the new grouping identifier in response to a situation in which the user does not want to use said existing

grouping identifier for the formed data item, said existing grouping identifier being associable with at least one other data item stored into the memory of the electronic device,

selecting means for selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier for synchronization, and

synchronizing means for synchronizing said data items between the electronic device and at least one another electronic device on the basis of the selected grouping identifier, said electronic devices being capable of communication connection with each other.

16. A device according to claim 15, wherein the electronic device further comprises a register of at least one grouping identifier being associable to at least one data item stored into the memory of the electronic device.

17. A device according to claim 15, wherein said associating means are further arranged to select said existing grouping identifier from the register on the basis of an input of the user of the electronic device.

18. A device according to claim 15, wherein said associating means are further arranged to select said existing grouping identifier from a register automatically on the basis of information in the stored data item.

19. A device according to claim 15, wherein said associating means are further arranged to create the new grouping identifier on the basis of input of a user of the electronic device.

20. A device according to claim 17, wherein said associating means are further arranged to store the new grouping identifier to the register of the electronic device.

21. A device according to claim 15, wherein said selecting means are further arranged to select the selected grouping identifier for the synchronization on the basis of input of a user of the electronic device.

22. A computer readable medium encoded with a computer program comprising:

computer program means for causing a first electronic device to store a data item for a first time into a memory of the first electronic device,

computer program means for causing the first electronic device to provide to a user of the first electronic device a possibility to select an existing grouping identifier for the stored data item,

computer program means for causing the first electronic device to associate the stored data item with said existing grouping identifier in response to a situation in which the user selects said existing grouping identifier for the formed data item, and to obtain a new grouping identifier and to associate the stored data item with the new grouping identifier in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, said existing group identifier being

associable with at least one other data item stored into the memory of the first electronic device,

computer program means for causing the first electronic device to select one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier for synchronization, and

computer program means for causing the first electronic device to synchronize said data items between said first electronic device and at least one another electronic device on the basis of said at least one selected grouping identifier, said electronic devices being capable of communication connection with each other.

(9) EVIDENCE APPENDIX

The undersigned attorney has not proffered any evidence submitted pursuant to 37 CFR 1.130, 1.131, or 1.132. However, the undersigned attorney relies upon the Notice of Panel Decision from Pre-Appeal Brief Review dated April 02, 2008, in which paper is written “The 102 rejection over Celik will be withdrawn” as well as the Request for Pre-Appeal Brief Review filed on February 27, 2008. No other evidence entered by the examiner is relied upon by appellant in the appeal.



Evidence

Notice of Panel Decision from Pre-Appeal Brief Review mailed April 2, 2008
Serial No. 10/645,687

Application Number 	Application/Control No. 10/645,687	Applicant(s)/Patent under Reexamination SIMELIUS ET AL.	
	Farhan Syed	Art Unit 2165	
Document Code - AP.PRE.DEC			

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed March 3, 2008.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-22

Claim(s) withdrawn from consideration: _____

The 102 rejection over Celis will be withdrawn.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Farhan Syed

(2) Christian Chace

(3) Eddie C. Lee

(4) _____



Evidence

Request for Pre-Appeal Brief review dated February 27 2008 entered March 3, 2008
Serial No. 10/645,687

Doc Code: AP.PRE.BEQ

PTAB 003 (1/1/05)

Approved for use through 12/31/05. OMB 0531-0230

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		879A.0048.U1(US)
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.510]. on _____ Signature _____ Typed or printed name: <u>Ann Olszowski</u>	Application Number 10/645,687	Filed 8/20/2003
	First Named Inventor Simeius, Kim	
	Art Unit 2165	Examiner Syed, F. M.
	Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.	
This request is being filed with a notice of appeal.		
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(d) is enclosed. (Form PTO-50399) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>43,423</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number (acting under 37 CFR 1.34) _____		
<div style="text-align: right;"><u>Walter J. Malinowski</u> Signature <u>Walter J. Malinowski</u> Typed or printed name <u>(203) 925-9490</u> Telephone number <u>Feb. 27, 2008</u> Date</div>		
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.		
<input type="checkbox"/> Total of _____ forms are submitted.		

This collection of information is required by 35 U.S.C. 112. The information is required to obtain or retain a benefit by the public which is to be paid by the USPTO in processing an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.4. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-5358 and select option 2.

Evidence

Request for Pre-Appeal Brief review dated February 27 2008 entered March 3, 2008
Serial No. 10/645,687



IN THE U.S. PATENT AND TRADEMARK OFFICE

In U.S. Patent Application of:

APPLICANT: Kim Simelius

SERIAL NO.: 10/645,637

FILING DATE: August 20, 2003

EXAMINER: Syed, Farhan M.

ART UNIT: 2165

ATTORNEY'S DOCKET NO.: 879A.0048.U1(US)

TITLE: METHOD AND APPARATUS FOR DATA TRANSMISSION

PRE-APPEAL BRIEF REQUEST FOR REVIEW ATTACHMENT

The following is a concise recitation of two clear errors in the Examiner's rejections in this application.

1. In the Final Office Action of November 27, 2007, the Patent Office rejected claims 1-22 under 35 U.S.C. 102(b) as being anticipated by Celik, U.S. Published Patent Application No. 2004/0236792 and claims 1-22 under 35 U.S.C. 103(a) as being unpatentable over Alam, U.S. Patent No. 6,524,544, in view of Changagne, U.S. Published Patent Application No. 2005/0036199, (for claims 9-11 and 21 in further view of Huston, U.S. Patent No. 6,141,663).

ERROR I: FAILURE TO TREAT ALL CLAIM LIMITATIONS

It was a first clear error on the part of the Patent Office to not identify with specificity where in the prior art reference the claimed subject matter of both an "existing grouping identifier" and a "new grouping identifier" is disclosed.

Regarding the "grouping identifier" and "data item," the Patent Office asserted in lines 1-3 of page 20 of the Final Office Action dated November 27 2007 as follows: "The Examiner refers to Figures 1, 2A, and 2B. The grouping identifier is the unique user identifier and the data item is the personal information that is targeted to be synced as described in Figures 1, 2A, and 2B."

Does the Patent Office mean that the "ID Number" is the grouping identifier? If so, then how does Celik account for "an existing grouping identifier" as well as "a new grouping identifier?" And, how would one of ordinary skill select between the existing grouping identifier and the new grouping identifier? On page 3, lines 4-6, of the Final Office Action dated November 27 2007, the Patent Office asserted "selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a

Evidence

Request for Pre-Appeal Brief review dated February 27 2008 entered March 3, 2008
Serial No. 10/645,687

Serial No: 10645687 Request for a Pre-Appeal Brief Conference
Art Unit: 2165

selected grouping identifier, synchronizing said data items" as being taught by Celik, presumably in Figure 2B (line 8, on page 3 of that Final Office Action).

Figure 2B of Celik shows '120' for "Assign account and unique ID" and '130' for "Print business cards with IDs (barcode optional)." There does not appear to be any selection, as recited in the claims, between an "existing grouping identifier" and a "new grouping identifier."

The Patent Office, on pages 2-3, of the Final Office Action dated November 27 2007, refers to paragraphs [0041]-[0043] of Celik (same as col. 5, line 65 - col. 7, line 24 of the Celik's patent US6374259) with respect to the following features of the independent claims of the present application:

"in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item with said existing grouping identifier, said existing grouping identifier being associable with at least one other data item, in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, establishing a new grouping identifier and associating the formed data item with the new grouping identifier,"

The Patent Office does not specify which feature or element recited in paragraphs [0041]-[0043] of Celik and that would correspond to the existing grouping identifier" and/or to "the new grouping identifier" recited in the above features.

Applicant could not find any other interpretation except that the Patent Office considers a "password" mentioned in the above passages of Celik as corresponding to the "existing grouping identifier" and/or to "the new grouping identifier" recited in the above features. In the paragraphs [0041]-[0043] of Celik, the password is an element that can be established and changed by a user (changing = creating a new password that replaces an old one).

However, if the "existing grouping identifier" and/or "the new grouping identifier" recited in the above features are made to correspond to the password, the following features of the independent claims are not taught by Celik (added remarks are in brackets):

"selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping

Evidence

Request for Pre-Appeal Brief review dated February 27 2008 entered March 3, 2008
Serial No. 10/645,687

Serial No.: 10/645,687 Request for a Pre-Appeal Brief Conference
Art Unit: 2165

Identifier [when a new password is created it replaces the old one, therefore an "existing password" and a "new password" cannot not be available for selection], and synchronizing said data items between said first electronic device and a second electronic device on the basis of said selected grouping identifier, said devices being capable of communication with each other [Celik does not teach to synchronize electronic devices on the basis of a password]."

Therefore, Celik does not teach all the limitations of the independent claims of the present application. Hence, the teaching of Celik does not anticipate the independent claims.

As such, Celik cannot anticipate claims 1-22.

ERROR II: MISAPPLICATION OF 35 USC 102(b) AND FAILING TO ATTRIBUTE SIGNIFICANCE TO NEWLY ADDED SUBJECT MATTER IN A CONTINUATION-IN-PART PATENT APPLICATION

It was a second clear error for the Patent Office to first treat Celik, U.S. Published Patent Application No. 2004/0236792 as a 35 U.S.C. 102(b) reference and second not to segregate out subject matter commonly disclosed by Celik, U.S. Published Patent Application No. 2004/0236792, but not disclosed by earlier patent applications from which Celik claims priority.

Celik, U.S. Published Patent Application No. 2004/0236792, is not a 35 U.S.C. 102(b) reference. It cannot be because it was not published or patented more than one year before the effective filing date of Applicant's patent application. The effective filing date of a reference, not the application being examined, is irrelevant for the purposes of applying sub-section b) of 35 U.S.C. 102.

MPEP § 706.02(a) states "If the publication or issue date of the reference is more than 1 year prior to the effective filing date of the application (MPEP § 706.02), the reference qualifies as prior art under 35 U.S.C. 102(b)." As Celik, U.S. Published Patent Application No. 2004/0236792, was not published until November 25 2004, it cannot be a 35 U.S.C. 102(b) reference against Applicant's current patent application.

As far as to whether U.S. Patent No. 6,374,529, may apply, the matter is moot as the Patent Office has not applied this reference.

Because, as the Patent Office correctly noted on page 19 of the Final Office Action dated November 27 2007, where Figures 1-8 of Celik, U.S. Published Patent

Evidence

Request for Pre-Appeal Brief review dated February 27 2008 entered March 3, 2008
Serial No. 10/645,687

Serial No.: 10/645,687 Request for a Pre-Appeal Brief Conference
Art Unit: 2165

Application No. 2004/0236792, and Figures 1-8 of Celik, U.S. Patent No. 6,374,259, form common subject matter, that commonly disclosed subject matter would be accorded the benefit of the filing date of the earlier of the two (i.e., Celik, U.S. Patent No. 6,374,259).

MPHP § 201.11 states as follows:

Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. The statute is so worded that the prior application may contain more than the later-filed application, or the later-filed application may contain more than the prior application, and in either case the later-filed application is entitled to the benefit of the filing date of the prior application as to the common subject matter disclosed in compliance with 35 U.S.C. 112, first paragraph.

As such, as pointed out on pages 9-10 of our response of September 17 2007, paragraphs 0065-0070 of Celik, U.S. Published Patent Application No. 2004/0236792 were newly added and so cannot qualify as prior art to reject the claims. Yet the Patent Office did just this for claims 8, 9, 10, 12, 20, and 21, in the Final Office Action dated November 27 2007.

Respectfully submitted:

Walter J. Malinowski
Walter J. Malinowski
Reg. No.: 43,423

February 27, 2008
Date

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(10) RELATED PROCEEDINGS APPENDIX

The undersigned attorney is not aware of any related proceedings or interferences.



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date shown below in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

May 2, 2008
Date

Clair F. Mian
Name of Person Making Deposit